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| 09/847,625 | 05/02/2001 | Luis A. Rovira | A-6671 | 5607 |

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EXAMINER

LAYE, JADE O

ART UNIT PAPER NUMBER

2617

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/847,625 | Applicant(s) ROVIRA, LUIS A. | |
| | Examiner Jade O. Laye | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

- I. Applicant's Claim amendments, dated 12/2/05, have been entered and made of record.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- II. Claims 1, 3, 4, 7, 8, 10-12, 18-21, 25, 28, 29, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis*. (WO 99/60790).

Claim 1 recites a method for providing media services comprising limitations which are too numerous to recite herein, however each will be addressed in turn. As discussed in a previous action, dated 4/15/2005, *Ellis* discloses a system, which provides a user with an IPG (Pg. 1, Ln. 4-7) identifying a future program (Pg. 13, Ln 7-10). A user is allowed to request said future program prior to its later scheduled broadcast time (i.e., user defined time prior to later start time). (Pg. 3, Ln. 7-10; Pg. 26, Ln. 4-7).

But, *Ellis* fails to teach whether the requested program is "otherwise available only via a scheduled broadcast to a plurality of users at a predetermined later time." However, it is well known in this art for newly released programs to be available on VOD, pay-per-view, or any other similar system before they are available on non-pay television. This enables movie

companies and content providers to receive additional profit. For Example, *Ellis* Figure 8, discloses the *Truman Show* being offered immediately in November of 1999 (PCT Publication date). A user is allowed to set a time for when he or she would like to view The Truman Show, but, it is not clear whether *The Truman Show* is “otherwise available only” via a later broadcast. However, the cited NPL reference (i.e., thestranger.com reference) shows the Truman Show being publicly available on NBC in February of 2001. These references, taken in combination, teach an IPG displaying a future television program (i.e., Truman Show), said future television program scheduled to be broadcast at a later time (i.e., on NBC in 2001), whereby the user is allowed to receive the program in advance of the later schedule time.

Furthermore, when taken in combination, it is inherent that the user would not otherwise receive the program in advance of its 2001 NBC date, unless he or she requested it in advance. Therefore, the *Truman Show* would be “available otherwise only” as a later scheduled broadcast on NBC. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant’s invention to modify the teachings of *Ellis* with what was well known (as evidenced by “thestranger.com” reference) to provide a system which allows a user to request programs in advance of their exclusive future broadcast date, thereby providing an additional method of television revenue.

Claim 36 corresponds to Claim 19. Thus, it is analyzed and rejected as previously discussed.

As to claim 3, *Ellis* further discloses charging a user a fee in connection with the provision of programs. (page 13, Ln. 18-20). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 3.

Applicant's claim 4 recites a method of charging a user a fee in connection with providing access to future programs. As discussed under Claim 3, *Ellis* discloses a method of charging a user a fee in connection with the "provision" of a later scheduled program, but fails to teach a method of charging said user a fee in connection with providing "access" to said programs. However, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to modify the billing method of *Ellis* to also include charging the user for having "access" to the future television programming. Charging a fee for access to a program is an obvious variant of charging a fee for the provision of the program, thereby allowing the content provider an additional avenue of charging a user.

Claim 21 is an apparatus claim corresponding to the method claim 4, and is analyzed and rejected as previously discussed.

As to claim 7, *Ellis* further discloses an IPG which list information pertaining to program titles, times, channels, and descriptions. (page 3, Ln. 1-3). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 7.

As to claim 8, *Ellis* further discloses an IPG, which utilizes a remote control device in order to display program information and to display the later schedule programs. (page 3, Ln 5-9). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 8.

As to claim 10, *Ellis* further discloses an IPG in which television programs are received from a broadcasting network or i.e., content provider. (Page 1, Ln. 11-13). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 10.

As to claim 11, *Ellis* discloses a method of storing a video on demand program within a home storage device (page 24, Ln. 4-9). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 11.

Claim 28 is an apparatus claim corresponding to the method claim 11, and is analyzed and rejected as previously discussed.

As to claim 12, *Ellis* further discloses an IPG system, which stores programs in devices capable of being connected, i.e., coupled, to a set-top box, i.e. client device. (Page 15, Ln. 28-32). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 12.

As to claim 18, *Ellis* further discloses an IPG, which provides user with access to current television programs (page 13, Ln. 10). Accordingly, the modified system of *Ellis* renders obvious all limitations of Claim 18.

Claims 19, 20, 25, 29 and 35 are apparatus claims corresponding to the method claims 1, 3, 7, 12, and 18 respectively. Accordingly, claims 19, 20, 25, 29 and 35 are analyzed and rejected as previously discussed.

III. Claims 2 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Kostreski* (US #5,534,912).

Applicant's claim 2 recites the method of Claim 1, further comprising confirming a user's authorization to receive a television program. As discuss above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to teach the use of any method of authorization. Within the same field of endeavor, *Kostreski* teaches a means for indicating which channels are authorized to a user. (Col 8, Ln. 3-22). Accordingly, it would have been obvious to

one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* with the authorization means of *Kostreski* in order to provide an efficient mechanism for verification.

Claim 22 is an apparatus claim corresponding to the method claim 2, and is analyzed and rejected as previously discussed.

IV. Claims 5, 6, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Matthews*, III (US #5815145).

Applicant's claim 5 discloses an IPG which contains a table corresponding to individual episodes of a given future television program. As discussed above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to disclose an IPG containing a episode database. However, within the same field of endeavor, *Matthews*, III, discloses an IPG database containing episodes corresponding to television programs. (Col. 7, Ln 48-49). Therefore, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* with the episode database of *Matthews* III in order to provide a more detailed and extensive program list for the user to choose from.

Claim 23 is an apparatus claim corresponding to the method claim 5, and is analyzed and rejected as previously discussed.

As to claim 6, *Ellis* further discloses that the programs listed in the IPG could be sit-coms or dramas, but fails to specifically list whether programs could be soap-operas. (Page 18, Ln. 20-21). However, claim 6 recites a Markush Group, which are anticipated if it is shown that one alternative is contained within the prior art. Accordingly, the modified system of *Ellis* renders

obvious all limitations of Claim 6. (Moreover, the examiner would like to note that soap operas are considered to be an obvious variant of a sit-com or drama, which were combined to provide a more exhaustive listing and would be rejected accordingly.)

Claim 24 is an apparatus claim corresponding to method claim 6, and is analyzed and rejected as previously discussed.

V. Claims 9, 15, 16, 17, 27, 32, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Girard et al.* (US # 5,751,282).

Applicant's claim 9 recites the method of claim 1, wherein the future television program is received from a headend. As discussed above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to specifically state that the program can be received from a headend. However, within the same field of endeavor, *Girard* teaches a video signal being received from a head end. (Col. 3, Ln 8-10). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* with the headend teaching of *Girard* in order to provide a multi-tier distribution structure.

Claim 27 is an apparatus claim corresponding to method claim 9, and is analyzed and rejected as previously discussed.

Applicant's claim 15 recites the method of claim 1, wherein the future program is stored in a device located inside a cable television system. As discussed above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to specifically disclose whether a storage device is located inside a cable television system. Within the same field of endeavor,

Girard discloses a program storage device, which is contained within a cable television system. (Fig. 1). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* with the storage device of *Girard* in order to provide an alternative method of storing said future programs.

Claim 32 is an apparatus claim corresponding to the method claim 15, and is analyzed and rejected as previously discussed.

Applicant's claim 16 recites a method of claim 1, wherein the future program is stored in a device coupled to a cable television system. As discussed above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to specifically state whether a storage device is coupled to a television system. Within the same of field of endeavor, *Girard* discloses that the program storage device is contained within or, i.e., coupled to, a cable television system. (Fig. 1). Accordingly it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* with the cable system storage teaching of *Girard* in order to provide an alternate method of storing said future programs.

Applicant's claim 17 recites the method of claim 1 wherein the user is provided with access to previously broadcasted television programs. As discuss above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to specifically discuss providing access to previously broadcasted television programs. Within the same field of endeavor, *Girard* teaches the user's access to previously broadcasted television programs. (Col. 2, Ln. 19-21 & 30-32). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of applicant's invention to further modify the system of *Ellis* to provide access to previously

broadcasted programs in order to provide the user with a wider selection of programs to choose from.

Claims 33 and 34 are apparatus claims corresponding to the method claims 16 and 17, respectively. Accordingly, they are analyzed and rejected as previously discussed.

VI. Claims 13, 14, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ellis* in view of *Gordon et al.* (US #5,682,597).

Applicant's claims 13 and 14 recite methods of storing said television programs in either a hub or node, respectively. As discussed above, the modified system of *Ellis* renders obvious all limitations of Claim 1, but fails to specifically state whether programs can be stored in hubs or nodes. Within the same field of endeavor, *Gordon* teaches the use of hubs and nodes, which are used to store video programs. (Col. 1, Ln. 65-68). Accordingly, it would have been obvious to one ordinarily skilled in this art at the time of applicant's invention to combine the modified system of *Ellis* with the hub and node storage teaching of *Gordon* in order to provide alternate methods of storage.

Claims 30 and 31 are apparatus claims corresponding to method claims 13 and 14, respectively. Accordingly, they are analyzed and rejected as previously discussed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
Initials: JL
February 17, 2006.


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
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